

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Masatomi et al. Confirmation No. 6287
Serial No.: 10/562,656
Group Art Unit: 1711
Filed: December 27, 2005
Legal Examiner: Dombroske, George
For: COATING COMPOSITION

PETITION FOR REVIVAL OF ABANDONED APPLICATION

Mail Stop PETITIONS
Attn: Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

The above-identified application became abandoned for, according to the United States Patent & Trademark Office (USPTO), failing to file a timely reply to a Notice of a Defective Response from the USPTO. Notification of abandonment was received in an untitled document from the Office of PCT Legal Administration on June 13, 2007 (copy attached). In response to this notification of abandonment, the Applicants hereby petition to revive the present application. The Applicants are petitioning under the unavoidable standard pursuant to 37 CFR § 1.137(a).

The delay in reply by the Applicants was unavoidable as evidenced by the following information. This information establishes an adequate showing of the cause of the unavoidable delay.

- On April 7, 2006, a Notification of Missing Requirements Under 35 U.S.C. 371 in the U.S. Designated/Elected Office (DO/EO/US), i.e., form PCT/DO/EO/905, was mailed to the Applicants, requiring submission of an oath or declaration in compliance with 37 CFR § 1.497(a) and (b) and a surcharge under 37 CFR § 1.492(h).
- Accordingly, on May 1, 2006, the Applicants filed a timely response to the Notification of Missing Requirements, along with a Japanese Language Declaration, i.e., form

PTO/SB/106, including signatures by all three inventors and the surcharge of \$130.00, as required. Notably, "Page 3 of 3" of form PTO/SB/106 provides in relevant part, "supply similar information for third and subsequent joint inventors". As such, Toru Masatomi and Motoshi Sasaki signed on "Page 3 of 3" of the Declaration, and Hideki Kobayashi signed on a supplemental page 4 of the Declaration (again labeled "Page 3 of 3" **due to current formatting of the USPTO's own form PTO/SB/106**).

- On November 9, 2006, a Notification of Defective Response, i.e., form PCT/DO/EO/916, was mailed to the Applicants, objecting to the Declaration filed on May 1, 2006, in view of MPEP 201.03(II)(B), which explains in relevant part that, "while each inventor need not execute the same declaration, each oath or declaration must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration."
- Accordingly, on November 24, 2006, the Applicants filed a timely response to the Notification of Defective Response, along with two copies of the Japanese Language Declaration, both including pages 1 through 3 with the inventors signatures on "Page 3 of 3" as previously described above. It was decided to adopt this procedure due to the restrictions associated with the formatting of form PTC/SB/106.
- On April 9, 2007, a Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR § 1.495, i.e., form PCT/DO/EO/903, was mailed by the USPTO to the Applicants, indicating the date of the present application under 35 U.S.C. 371 (c) (1), (2), and (4) to be November 24, 2006. In the USPTO's own words, this document clearly indicates that the date of completion of ALL 35 U.S.C. 371 requirements is 11/24/2006. In other words, the USPTO clearly indicated that the previously filed Declaration was acceptable.
- On April 9, 2007, the USPTO also mailed an Official Filing Receipt clearly acknowledging claims of priority (domestic and foreign) and other information which clearly indicated to the Applicants that the USPTO had examined and accepted the previously filed Declaration (otherwise the Official Filing Receipt would not have acknowledged the claims of priority which originated in the Declaration).
- Relying upon this Notice of Acceptance and also on the Official Filing Receipt, both from the USPTO, the Applicants understood that no further action was required on their part.
- Receiving no communication whatsoever from the USPTO since the Notice of Acceptance and the Official Filing Receipt, surprisingly, on June 13, 2007, the Applicants received an untitled document from the Office of PCT Legal Administration. This document was a response to the Applicants' timely filed response of November 24, 2006. In this document,

the PCT Legal Examiner, Mr. George Dombroske, indicated that the Notice of Acceptance was defective, and therefore, vacated. In so doing, Mr. Dombroske vacated the USPTO's own form...not the Applicants' form. The PCT Legal Examiner also indicated that, since the Notification of Defective Response to the Applicants' first Declaration set a non-extendable time limit and since that time limit has now expired (that time limit actually expired long ago, even before Mr. Dombroske mailed his communication), the application is abandoned.

- In accordance with obligations under the Rules, the Applicants, at all times, acted in good faith to advance the subject application. As a result of the USPTO's communications clearly indicating acceptance of the previously filed Declaration, the Applicants had no reason to file a second response to the Notification of Defective Response before the present application went abandoned.
- If given notice of any issues with the Declaration filed on November 24, 2006, such as by receiving a Second Notification of Defective Response, the Applicants could have filed another timely response addressing any new issues presented by upon investigation of the Declaration. However, the Applicants were given no such opportunity prior to the present application going abandoned.
- As described above, notification of abandonment of the present application was not received by the Applicants until June 13, 2007 and since this receipt, the Applicants have been diligently confirming the various facts present within the file history. In view of the timeline and these facts, the Applicants, throughout the month of July 2007, made several telephone contacts with Mr. Dombroske discussing the present issues and the equities associated therewith. Since June 13, 2007 and these communications with Mr. Dombroske and up to the filing of the subject Petition, the Applicants have been in the process of preparing the subject Petition and an additional Declaration, including obtaining new signatures from Japan. Regarding the additional Declaration, the Applicants have modified the current version of form PTO/SB/106, to make clear to the PCT Legal Examiner and all others that each of the inventors executed the new Declaration indicating the entire inventive entity.
- In view of the foregoing, the Applicants respectfully submit that an adequate showing of the cause of the delay has been set forth above. Specifically, the Applicants merely complied with all of the previous indications of acceptance of the present application. The Applicants were unaware of any additional issues regarding the Declaration filed on November 24, 2006, specifically the issues indicated by the PCT Legal Examiner in the communication received June 13, 2007, and thus merely relied on the previous Notice of Acceptance and the Official Filing Receipt dated April 9, 2007. Any issues with the previously filed Declaration were not known before the present application went abandoned.

Even if it is concluded that mistakes were made, Applicants, when acting in good faith to advance an application, are entitled to timely notice of defective responses from the USPTO. Applicants should not be responsible for additional USPTO investigation that occurs outside a window of timing for an Applicant to take action, especially when, to the contrary, the USPTO in fact mailed the Notice of Acceptance and Official Filing Receipt for the present application, essentially validating the previously filed Applicants' Declaration. It should also be noted that the Applicants were operating within the limitations of the current USPTO form PTO/SB/106, currently available from the USPTO's own website. This form merely states to "supply *similar* information and signature for third and subsequent joint inventors" (emphasis added). The Applicants in fact supplied this similar information and the signature in accordance with the specific instructions on the form.

The Applicants are convinced that abandonment of the present application and the entire delay in filing the required reply from the due date for the reply until the filing of the subject Petition was unavoidable, as fully detailed in the information set forth above. Thus, the Applicants respectfully request that the present application be revived pursuant to 37 CFR § 1.137(a).

While, as indicated above, the Applicants are convinced that the burden of proof required pursuant to 37 CFR § 1.137(a) has been satisfied, the Applicants respectfully request, in the alternative, a Petition to Revive under the unintentional standard pursuant to 37 CFR § 1.137(b). In the case of this alternative, the entire delay in filing the required reply from the due date for the required reply until the filing of the subject Petition under 37 CFR § 1.137(b) was unintentional.

This Petition to Revive is also submitted with an additional Declaration. Upon grant of this Petition to Revive, the Applicant's respectfully request that this Declaration be entered.

The Commissioner is authorized to charge the \$500.00 fee pursuant to 37 CFR § 1.137(a), or in the alternative, the \$1500.00 fee pursuant to 37 CFR § 1.137(b), to Deposit Account No. 08-2789 in the name of Howard & Howard. If any additional fees are necessary to revive the present application, you are hereby authorized to charge such fees to Deposit Account No. 08-2789 in the name of Howard & Howard.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS

August 15, 2007

Date

/David M. LaPrairie/

David M. LaPrairie, Registration No. 46,295

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Attachment: 2 pages

11 JUN 2007



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HOWARD & HOWARD
JUN 13 2007
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In re Application of
Masatomi et al.
Application No.: 10/562,656
PCT No.: PCT/JP04/09403
Int. Filing Date: 25 June 2004
Priority Date: 27 June 2003
Attorney Docket No.: 71,051-026
For: Coating Composition

DECISION

This is in response to the declaration of the inventors filed on 24 November 2006.

BACKGROUND

This international application was filed on 25 June 2004, claimed an earlier priority date of 27 June 2003, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 06 January 2005. The 30 month time period for paying the basic national fee in the United States expired at midnight on 27 December 2005. Applicant filed *inter alia* the basic national fee on 27 December 2005.

On 07 April 2006, a Notification Of Missing Requirements... (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h).

On 01 May 2006, applicants filed a response, including a declaration and the \$130.00 surcharge.

On 09 November 2006, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicant, objecting to the declaration filed on 01 May 2006 in view of "MPEP 201.03(II)(B)."

On 09 April 2007, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicants, indicating the date of this application under 35 U.S.C. 371(c)(1), (2) and (4) to be 24 November 2006.

DISCUSSION

Inspection of the declaration documents filed on 24 November 2006 reveals that one document nominates and is executed by Toru Masatomi and Motoshi Sasaki, while the other declaration document nominates and is executed by Hideki Kobayashi. Neither document nominates the entire inventive entity shown on the published international application. Applicants' attention is drawn to MPEP 201.03, which explains in part that

While each inventor need not execute the same declaration, each oath or declaration executed must contain a complete listing of all inventors so as to

clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

Since neither of the declaration documents filed on 24 November 2006 "contain[s] a complete listing of all inventors," they are not acceptable for purposes of compliance with 37 CFR 1.497(a) and (b). Therefore, the Notice of Acceptance mailed on 09 April 2007 was defective, and it is hereby **VACATED**.

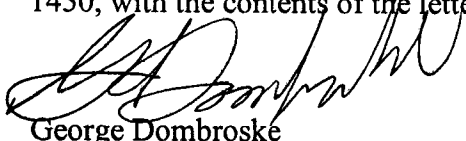
Inspection of the declaration filed on 01 May 2006 reveals that inventors Masatomi and Sasaki are nominated on one page "3 of 3," while inventor Kobayashi is nominated on a separate page "3 of 3." As such, it is not clear from inspection of the declaration itself whether each inventor executed a complete declaration document nominating the entire inventive entity.

DECISION

The declarations filed on 01 May 2006 and 24 November 2006 are **NOT ACCEPTED**, without prejudice.

Since the defective declaration filed on 24 November 2006 was in response to a Notification of Defective Response (Form PCT/DO/EO/916) which set a non-extendable time limit in which to perfect the declaration requirement, and since said time period has now expired, this application stands **ABANDONED** with respect to the national stage in the United States. Applicants may wish to consider filing a petition under 37 CFR 1.137(b) in the event that revival is sought.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



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